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REMARKS

Claims 1-3 and 5-14 are pending, with claims 10-14 being indicated as allowable (*see* page 12 of outstanding Office Action). With regard to claims 10-14, the Examiner has appeared to inadvertently label them as "withdrawn," and omitted claim 14 entirely, *in the Office Action Summary*. It is respectfully requested that the Examiner properly label claims 1-3 and 5-14 as pending (claim 4 was previously canceled) and claims 10-14 as allowed (box 5) consistent with page 12 of the Office Action.

As a preliminary matter, it is noted that the Examiner has made the outstanding Office Action final based on the perfection of Applicants' claim to foreign priority (*see* top of page 13 of outstanding Office Action). However, perfecting foreign priority is NOT a proper basis for making a rejection final. Indeed, the cited portion of MPEP § 706.07(a) expressly states that the Examiner should anticipate that Applicants will do what is necessary to antedate a prior art reference when possible, so that a new rejection can not be made final in such an instance if the claims are not amended. Accordingly, as the claims in the instant case were not amended, the finality of the outstanding Office Action is respectfully traversed. It is therefore respectfully requested that the enclosed amendment be treated as a response to a non-final Office Action, whereby the amendments should be entered and considered as a matter of right.

Claims 1 and 9 are the rejected independent claims and stand rejected under 35 U.S.C. § 103 as being unpatentable over JP '630, JP '161, or JP '442 in view of JP '222. These rejections are respectfully traversed for the following reasons.

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Claims 1 and 9 each embody the diameter of the current collector plate being greater than the inner diameter of the battery case. Support for this feature is shown in the exemplary embodiments illustrated in Applicants' drawings. Indeed, as described on page 15, line 20 - page 16, line 8 of Applicants' specification, in view of the aforementioned feature in the specified *combination*, the current collector plate and the electrode group can be bonded prior to inserting the electrode group into the battery case. Because the diameter of the current collector plate is greater than the inner diameter of the battery case, the periphery of the current collector plate can function as a stopper when inserting the bonded current collector plate and the electrode group. This can eliminate the necessity to position the electrode group in the battery case. This can also reduce the possibility of gap formation between the current collector plate and the opening end of the battery case, thus achieving secure welding. Moreover, this can make welding easier in the production process since the welding from the bottom to the opening end of the battery case would be easier than that from the periphery of the opening end of the battery case to the periphery of the current collector plate.

In contrast, each of JP '630 and JP '161 disclose current collector plates having diameters that are smaller than the inner diameter of the respective cases. Moreover, with respect to JP '442, it is respectfully submitted that the proposed combination is improper. Specifically, the current collector plate of JP '442 has protrusions thereon (refer to FIG. 3) which are not amenable to connecting to the bent portions of JP '222. In this regard, the Examiner's motivation for making the combination (i.e., to improve contact surface) would fail in that the protrusions would prohibit a bent portion/flat collector-face connection.

Indeed, without the protrusions, in the specific battery arrangement disclosed by JP '442, it would be impossible to securely weld the current collector plate and the electrode group in the

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battery case, thereby evidencing the importance of the protrusions to the device of JP '442 in that the protrusions make the connection between the current collector plate and the electrode group secure (i.e., a gap would otherwise be formed when the opening end of the case is simply covered by the current collector plate). However, the protrusions are subject to wedge into the end surface of the electrode group, resulting in deformation of the electrode group. In other words, it would be extremely difficult to connect only one of the electrodes included in the electrode group to the current collector plate, so that using the current collecting structure of JP '442 would increase the occurrence of short circuit defects and adversely affect reliable welding.

In contrast, according to one aspect of the present invention, a bent portion of one of the electrodes can be formed so as to contact the current collector plate, which can secure the connection between the current collection plate and the electrode group and increase the connection strength. Accordingly, the *combination* of bent portions and having a "diameter of said current collector plate [be] greater than the inner diameter of said battery case" can effect the new and unexpected result of making welding easier and reliable, thereby evidencing the criticality of the recited *combination*. On the other hand, JP '442 and JP '222 are completely silent as to such effects, let alone suggest how to realize such effects. Indeed, modifying JP '442 with the bent portions of JP '222 would render JP '442 inoperable for its intended purpose of using the protrusions to secure the electrode group, by, for example, eliminating the needed flat surface to make a connection with the bent portion and causing short circuits as discussed above. The Examiner is directed to MPEP § 2143.01 under the sub-title "The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose", which sets forth the applicable standard:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to

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make the proposed modification. (citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)).

Accordingly, pursuant to MPEP § 2143.01, "there is no suggestion or motivation to make the proposed combination." Indeed, the proposed combination would serve a redundant purpose of securing the connections in that the protrusions of JP '442 already serve the purpose of securement so that the securing functionality of JP '222 would not be necessary.

As mentioned above, in the present invention, the value of the "bent portion" can be enhanced by being incorporated in combination with the feature that "the diameter of said current collector plate is greater than the inner diameter of said battery case." Whereas, JP '442 discloses only that the current collector plate and the electrode group are connected securely by providing protrusions on the current collector plate so that there would be no need or desire to protrude an end of one electrode from an end surface of the electrode group in order to securely connect the current collector plate and the electrode group. Accordingly, there is no motivation to combine JP '442 with JP '222.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 1 and 9 because the proposed combinations fail the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained

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in the dependent claims, *Hartness International Inc. v. Simplicatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 and 9 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

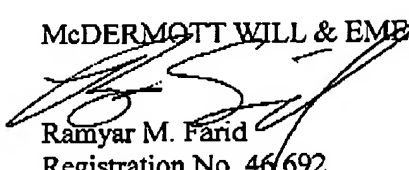
Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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